

REMARKS

Favorable reconsideration is respectfully requested in view of the foregoing amendments and the following remarks.

I. CLAIM STATUS

Claims 8, 9 and 11-16 were pending in this application when last examined and stand rejected.

II. ADVISORY ACTION

In the continuation of item 11 on page 2 of the Advisory Action, it was indicated that the 102 and 103 prior art rejections have been withdrawn. It was also indicated that the enablement rejection under 35 U.S.C. § 112, first paragraph, has been maintained.

III. ENABLEMENT REJECTION

The Examiner has maintained the enablement rejection under 35 U.S.C. § 112, first paragraph, as it applies to claim 8, 9 and 11-16. See page 2 of the Advisory Action. The Office again contends that the specification does not enable a functional probe with a labeling substance 0 to 1 base pairs apart from an energy-absorbing substance due to the close proximity of each substance.

In reply to Applicant's arguments that the specification contains working examples in Nos. 14, 17, 21 and 24 of Table 1 on pages 13-14, the Office indicated that the invention is unpredictable, because Table 1 (Nos. 15, 18, 20 and 23) also discloses probes with a labeling substance 0 to 1 base pairs apart from an energy-absorbing substance that do not appear to function as claimed (i.e., fluorescent intensity is kept at control levels, and thus quenching occurs). In other words, the rejection was maintained on the basis that Nos. 15, 18, 20 and 23 do

not function as claimed, because the fluorescent intensity remains at control levels, and thus quenching occurs.

This rejection is respectfully traversed.

The test of enablement is whether one reasonably skilled in the art can make or use the invention based on the disclosure in the specification coupled with the knowledge in the art without undue experimentation. See M.P.E.P. § 2164.01.

It is respectfully submitted that the Office has misunderstood the results in Table 1 with regard to case Nos. 15, 18, 20 and 23.

In particular, please note that the probes of EFN1-FP and EFN2-FP (case Nos. 13 to 18) are targeted to EC1, while EC2 was added in the case of Nos. 15 and 18. Therefore, it would be apparent that EFN1-FP and EFN2-FP in the case of Nos. 15 and 18 do not hybridize with EC2 and the fluorescent intensity remains at control levels.

Similarly, the probes of EFN3-FP and EFN4-FP (case Nos. 19 to 24) are targeted to EC2, while EC1 was added in the case of Nos. 20 and 23. Therefore, it is apparent that EFN3-FP and EFN4-FP in the case of Nos. 20 and 23 do not hybridize with EC1 and that the fluorescent intensity remains at control levels.

Thus, in contrast to the Office's position, case Nos. 15, 18, 20 and 23 in Table 1 do not demonstrate that the claimed probes are sometimes non-functional. Accordingly, the results in Table 1 do not provide a basis for asserting that the claimed invention is unpredictable as asserted in the Action..

Again, as argued in the previous response, Nos. 14, 17, 21 and 24 in Table 1 correspond to cases where both the labeling substance and the energy-absorbing substance are linked to probes and where their homologous sequences are provided in the solutions. As demonstrated at page 14, lines 15-22, the probes as shown in Nos. 14, 17, 21 and 24 show an increase of fluorescent intensity upon hybridization. Thus, it is respectfully submitted that the specification provides working examples of the claimed probes.

Therefore, it is again respectfully submitted that based on these examples and the guidance in the disclosure, one of skill in the art could make and use the claimed probes without undue experimentation.

Therefore, the enablement rejection of claims 8, 9 and 11-16 under 35 U.S.C. § 112, first paragraph, is untenable and should be withdrawn.

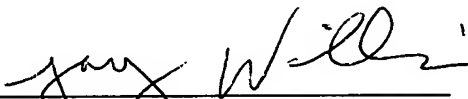
CONCLUSION

In view of the foregoing amendments and remarks, it is respectfully submitted that the present application is in condition for allowance and early notice to that effect is hereby requested.

If the Examiner has any comments or proposals for expediting prosecution, please contact the undersigned attorney at the telephone number below.

Respectfully submitted,

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